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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/716,637
Filing Date: November 18, 2003
Appellant(s): COOPER, JONATHAN D.

Mitchell Rosenfeld
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 6, 2006 appealing from the Office action mailed November 8, 2004.

Art Unit: 3621

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|----------------|---------|
| 5,963,647 | DOWNING ET AL. | 10-1999 |
| 6,044,360 | PICCIALLO | 03-2000 |
| 6,039,250 | ITO ET AL. | 03-2000 |
| 5,936,221 | CORDER ET AL. | 08-1999 |

Art Unit: 3621

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 59, 61, 68-79, 72-73 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al, U.S. Patent No. 5,963,647 in view of Picciallo, U.S. Patent No. 6,044,360.**

As per Claims 59, 61 and 73, Downing et al disclose an automated process for sending money from a first location to a second location comprising:

- receiving a request for a secure money transfer from a requestor (Col. 6, lines 18-30);
- receiving information associated with a recipient for said secure money transfer (Col. 6, lines 18-30);
- receiving information indicating an amount of said secure money transfer (Col. 6, lines 18-30);
- assigning an authorization to the secure money transfer for using the secure money transfer instrument in automated teller machines wherein the authorization includes an access code in order to receive money at the ATM (Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45);

Art Unit: 3621

- providing said access code from said requestor to said recipient (Col. 7, lines 6-18);
- whereby said access code enable said recipient to withdraw funds using automated teller machines (Col. 4, lines 35-50; Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45).

Downing, however, fails to explicitly disclose the use of a standard atm card configured to enable the completion of the secure money transfer and wherein the computer readable medium is delivered to the recipient consumer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds from a sender to a recipient and further teaches that a computer readable medium such as an atm card is configured to enable the completion of the secure money transfer using atm machines (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium such as a standard atm card to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient, thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

As per **Claims 68 and 72**, Downing et al disclose an automatic money transfer system for transferring money from a donor to a donee comprising:

- an automated server system for facilitating the secure transfer of money from a donor to a donee, and to assign a security code to said transfer (Col. 6, lines 18-30);
- a data storage device for recording said secure transfer (Col. 5, lines 60-65; Col. 6, lines 50-65; Col. 8 line 35-Col. 9 line 20); and
- enabling the donee to access the funds from an ATM using the security code (Col. 7, lines 18-28; Col. 12, lines 10-45).
- wherein said donor provides the security code to the donee (Col. 7, lines 6-18).

Downing, however, fails to explicitly disclose the use of a standard atm card configured to enable the completion of the secure money transfer and wherein the computer readable medium is delivered to the recipient consumer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds from a sender to a recipient and further teaches that a computer readable medium such as an atm card is configured to include machine readable information and enable the completion of the secure money transfer using atm machines (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium such as a standard atm card to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the

Art Unit: 3621

recipient, thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

As per **Claim 69**, Downing et al fail to disclose wherein the security code is contained in the machine readable information. Examiner takes Official Notice, however, that storing a security code in machine readable information on a standard ATM card is notoriously well known in the art. Security codes such as PINs are typically encoded on the magnetic stripe of standard ATM cards and it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use the magnetic stripe to store a security code in order to ensure that the card is not being used by an unauthorized user.

As per **Claim 70**, Downing et al further disclose wherein the security code must be manually entered on the atm by the donee in order for the donee to receive money (Col. 7, lines 29-45).

As per **Claim 75**, Downing et al further disclose wherein the access code is provided to the recipient by the sender (Col. 7, lines 6-18).

Art Unit: 3621

3. Claims 60, 71 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al, U.S. Patent No. 5,963,647 and Picciallo, U.S. Patent No. 6,044,360 as applied above and further in view of Ito et al, U.S. Patent No. 6,039,250.

As per Claims 60, 71 and 74, Downing et al and Picciallo fail to disclose determining whether the recipient receives the secure money transfer instrument and providing a credit to the sender if not. Ito et al disclose an electronic money sending system and teaches that the sender receives a refund in the amount of the requested transfer in the case where the recipient does not receive the funds (Col. 2, lines 34-47; Col. 5 line 65-Col. 6 line 5; Col. 7, lines 38-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brody et al and provide a means for crediting or refunding the transfer amount back to the sender as taught by Ito et al in case the card or funds are not actually received by the recipient. The motivation for this was well known at the time of applicant's invention. For example, if the card or funds cannot be delivered to the recipient, then they would naturally be returned to the sender to avoid the loss of money to the sender.

4. Claims 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al, U.S. Patent No. 5,963,647 and Picciallo, U.S. Patent No. 6,044,360 as applied above and further in view of Corder et al, U.S. Patent No. 5,936,221.

As per Claims 62-63, Downing et al further disclose wherein the secure money transfer is used to transfer money from the requestor located in a first country to a recipient located in a

Art Unit: 3621

second country using different currencies from different nationalities (Col. 3, lines 60-65; Col. 6, lines 25-47). Downing et al, however, fail to disclose that the requestor may allocate additional money to the secure money transfer instrument via a communications network. Corder et al disclose a system and method for transferring value to a card and further disclose that additional funds may be added and transferred to the card via a communications network (Col. 2, lines 20-39). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing et al and include the ability to add additional funds to the secure money transfer to provide a convenient method for the recipient to have access to additional funds when the original transfer amount is depleted.

As per **Claims 64-66**, Downing et al disclose an automated process for sending money from a first location to a second location comprising:

- receiving a request for a secure money transfer from a requestor indicating a destination for said transfer and an amount for transfer via a communications network (Col. 6, lines 18-30);
- assigning an authorization to the secure money transfer for using the secure money transfer instrument in automated teller machines wherein the authorization includes an access code in order to receive money at the ATM.(Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45);
- providing said access code from said requestor to said recipient (Col. 7, lines 6-18);
- whereby said access code enables said recipient to withdraw funds using automated teller machines (Col. 4, lines 35-50; Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45).

Art Unit: 3621

Downing, however, fails to explicitly disclose the use of a standard atm card configured to enable the completion of the secure money transfer and wherein the standard atm card is delivered to the recipient consumer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds from a sender to a recipient and further teaches that a computer readable medium such as an atm card is configured to enable the completion of the secure money transfer using atm machines (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium such as a standard atm card to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient, thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

Downing et al further fail to explicitly disclose that the requestor submit additional requests for allocating additional money to the atm card via a communications network. Corder et al disclose a system and method for transferring value to a card and further disclose that additional funds may be added and transferred to the card via a communications network (Col. 2, lines 20-39). It would have been obvious to one of ordinary skill in the art at the time of

Art Unit: 3621

applicant's invention to modify the method of Brody et al and include the ability to add additional funds to the secure money transfer to provide a convenient method for the recipient to have access to additional funds when the original transfer amount is depleted.

5. Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al, U.S. Patent No. 5,963,647 in view of Picciallo, U.S. Patent No. 6,044,360 and Corder et al, U.S. Patent No. 5,936,221 as applied above and further in view of Ito et al, U.S. Patent No. 6,039,250.

As per **Claim 67**, Downing et al, Picciallo and Corder et al et al fail to disclose determining whether the recipient receives the secure money transfer instrument and providing a credit to the sender if not. Ito et al disclose an electronic money sending system and teaches that the sender receives a refund in the amount of the requested transfer in the case where the recipient does not receive the funds (Col. 2, lines 34-47; Col. 5 line 65-Col. 6 line 5; Col. 7, lines 38-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing et al, Picciallo and Corder et al and provide a means for crediting or refunding the transfer amount back to the sender as taught by Ito et al in case the card or funds are not actually received by the recipient. The motivation for this was well known at the time of applicant's invention. For example, if the card or funds cannot be delivered to the recipient, then they would naturally be returned to the sender to avoid the loss of money to the sender.

(10) Response to Argument

1. Issue A: Group I

In its recent decision, the Federal Circuit stated that “[a]lthough our predecessor court was the first to articulate the motivation-suggestion-teaching test a related test-the analogous art test-has long been part of the Graham analysis articulated by the Supreme Court.” *In re Kahn*, No. 04-1616 (Fed. Cir. March 22, 2006). “The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection.” *Id.* “References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art.” *Id.* “[I]t is necessary to consider the reality of the circumstances - in other words, common sense-in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” *Id.* “We have explained that this test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and that it is meant to defend against hindsight.” *Id.*

“In many, if not most, situations, there is neither a motivation to make the modification clearly articulated in the references nor an evident lack of motivation. Rather, the prior art references typically disclose elements or aspects of the claimed subject matter, but fail to specifically point the way toward the combination, substitution or other modification needed to arrive at the invention. A judgment must be made whether a person of ordinary skill in the art would have had sufficient motivation to combine the individual elements forming the claimed invention.” *In re Clinton*, 527 F.2d, 1226, 1228, 188 USPQ 365, 367 (C.C.P.A. 1976).

Art Unit: 3621

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Downing discloses a system and method for transferring funds wherein the recipient can receive transferred cash through an ATM and Picciallo describes a method of delivering the computer readable medium (i.e., ATM card) directly to either the sender or the recipient, thereby providing a convenient means by which distribution of the card and its usage can be controlled by the sender. A person of ordinary skill in the art would have had sufficient motivation to utilize a computer readable medium such as a credit/ATM card since these medium are so well known and the devices that accept these mediums are readily available in virtually any location.

Appellant's argument referring to a specific embodiment of Downing (cardless withdrawal) on page 10 of the brief does not negate or teach away from other embodiments that support the combination of the references. Furthermore, the fact that Appellant argues against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

2. Issue B: Group 2

Appellant argues “Ito fails to teach determining whether the recipient receives the electronic money and, if not, providing a monetary credit to the sender (brief p. 11).” Ito was introduced to disclose an electronic money sending system wherein the sender receives a refund in the amount of the requested transfer in the case where the recipient does not receive the funds. Appellant’s argument is without merit.

Appellant further asserts that the “Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense (brief p. 11).” Rather, Appellant states, “the Board must point to some concrete evidence in the record in support of these findings.” *Id.* The examiner respectfully disagrees with Appellant’s narrow application of precedent and directive to the Board. In fact, the Examiner points the Appellant to the recent decision of the Federal Circuit affirming the Board. The decision stated, “[a]lthough our predecessor court was the first to articulate the motivation-suggestion-teaching test a related test-the analogous art test-has long been part of the Graham analysis articulated by the Supreme Court.” *In re Kahn*, No. 04-1616 (Fed. Cir. March 22, 2006). “The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection.” *Id.* “References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art.” *Id.* “[I]t is necessary to consider the reality of the circumstances - in other words, common sense-in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the

Art Unit: 3621

inventor.” Id. “We have explained that this test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and that it is meant to defend against hindsight.” Id.

3. Issue C: Group 3

Appellant relies on arguments presented under Issue A, accordingly, the Examiner relies on the response noted above.

4. Issue D: Group 4

Appellant relies on arguments presented above under Group 1-3, accordingly, the Examiner relies on the responses presented above.

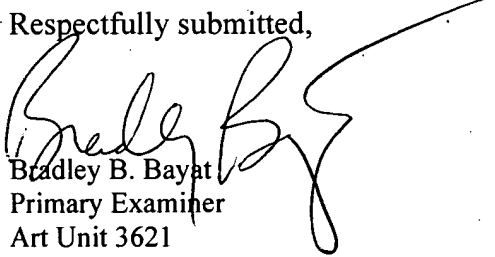
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

Art Unit: 3621

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Bradley B. Bayat
Primary Examiner
Art Unit 3621

Conferees:

Andrew Fischer, SPE 3621

Kambiz Abdi, Primary 3621

